Supreme Court
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No.

IN THE

Supreme Court of the United States

Mitchell R. Swartz, *Petitioner*

v.

Q. Todd Dickinson, Director of the USPTO,
Commissioner of Patents and Trademarks,
Respondent

On Petition For A Writ Of Certiorari
To United States Court Of Appeals
For The Federal Circuit
00-1107 (Serial No. 07/371,937)
00-1108 (Serial No. 07/760,970)

PETITION FOR A WRIT OF CERTIORARI

Mitchell R. Swartz, ScD, MD, EE
P.O. Box 81135
Wellesley Hills, MA 02481-0001
(781) 237-3625

January 18, 2001

55 pp

QUESTIONS PRESENTED

1. Whether the U.S. Patent and Trademark Office [hereinafter "Office"] has replied to duly-submitted unrebutted Declarations with conclusive effect regarding issues of material fact.

2. Whether the Office complied with its own Rules regarding MPEP 707.07(j) and 706.03(d).

3. Whether the Office complied with the standards of review regarding definiteness under 35 U.S.C. §112 ¶2.

4. Whether the Office complied with the standards of review regarding operability under 35 U.S.C. §112 ¶1.

5. Whether the Office complied with the standards of review regarding utility under 35 U.S.C. §101.

6. Whether the Office has violated the United States Constitution.

LIST OF PARTIES

Not all parties appear in the caption of the case on the cover page.

THE LIST OF ALL PARTIES PROCEEDINGS IN THE COURT IS AS FOLLOWS:

Petitioner, previously Appellant and Applicant, Dr. Mitchell Swartz, P.O. Box 81135, Wellesley Hills, MA 02481-0001.

Respondent is the Office of Patent and Trademarks [the U.S. Patent and Trademark Office and the Board of Patent Appeals and Interferences, hereinafter "Office"]

The Examiner has been Mr. Daniel Wasil. Mr. Q. Todd Dickinson, is Director of the USPTO, and Commissioner of Patents and Trademarks.

The Respondent's attorney of record is Attorney Mark Nagumo, Associate Solicitor, 2121 Crystal Drive, P.O. Box 15667, Arlington, Virginia, 22215.

With him has been Albin F. Drost, Acting Solicitor, U.S. Patent and Trademark Office, of Arlington, Virginia, for the Director of the United States Patent and Trademark Office, John M. Whealan, Stephen Walsh, Maximilian R. Peterson and Nancy C. Sluter.

The four *amicus curiae* who have submitted Briefs to the court of appeals are

Eugene F. Mallove, Sc.D., *amicus curiae*, New Energy Research Laboratory (NERL), P.O. Box 2816, Concord, New Hampshire 03302-2816

Scott R. Chubb, Ph.D., *amicus curiae*, Research Systems, Inc., 9822 Pebble Weigh Ct., Burke, VA 220215-3378

Hal Fox, Ph.D., *amicus curiae*, Engineer, Editor, 3084 E. 3300 South, Salt Lake City, UT 84109-2154

Thomas Valone, MS, *amicus curiae*, former Patent Examiner, Integrity Research Institute, 1422 K Street NW, Suite 204, Washington, DC 20005

The panel in the Court were Judges Dyk, Archer, and Plager of the U.S. Court of Appeals for the Federal Circuit.

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Supreme Court of the United States

On Petition For A Writ Of Certiorari
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00-1107 (Serial No. 07/371,937)
00-1108 (Serial No. 07/760,970)

PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully prays that a writ of certiorari issue to review the two judgments of the United States court of appeals which appear at Appendix A and Appendix B in the present petition.

OPINIONS BELOW

The opinion of the court of appeals [United States Court Of Appeals For The Federal Circuit ("CAFC") 00-1107] appears at Appendix A to this Petition and is published.

The opinion of the court of appeals [CAFC 00-1108] appears at Appendix B to this Petition and is published.

JURISDICTION

The jurisdiction of this Court is invoked under 35 U.S.C. 112 and the United States Constitution [Article I, Section 8, Clause 8, Article III, Article IV, and the Fifth and Fourteenth Amendments].

The date on which the court of appeals decided Petitioner's cases was 11/8/00. A timely petition for rehearing was submitted and was thereafter denied by the court of appeals on 12/8/2000. A copy of the orders denying rehearing appears at Appendix C [CAFC 00-1107] and Appendix D [CAFC 00-1108] in the present petition.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This court is the Petitioner's last and only source of relief. The court of appeals has decided an important federal question that conflicts with more than a dozen relevant decisions of the US Supreme Court and other courts of appeal, and has thus far departed from the accepted and usual course of judicial proceedings.

This Petition involves a direct grant of authority made under Article I, §8, cl. 8 of the United States Constitution. The provision of Art. I, §8, cl. 8 reads:

> **"Congress shall have Power (t)o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".**

Congress has spoken to "encourage progress" [*Diamond v. Chakrabarty*, 447 U.S. 303 (1980), 447 U.S. 303, No. 79-136, quoting Deepsouth Packing Co. v. Laitram Corp., 406 U.S. 518, 530 -531 (1972); Graham v. John Deere Co., 383 U.S. 1, 7 -10 (1966)], encourage ingenuity [447 U.S. 303, 309], and has defined patentable statutory subject matter to include "anything under the sun that is made by man." [S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)]. There is no doubt that would include inventions involving energy efficiency and -monitoring within the meaning of the statute.

The Office of Patents and Trademarks ("Office") has systematically ignored unrebutted timely-submitted Declarations pertaining to issues of fact, and has ignored its own rules, and thus has created a non-uniform and arbitrary standard of review for patentability. In doing so, the Office has acted under color of federal law [*Osborn v. Bank of United States*, 22 U.S. (9 Wheat) 738 (1824)] and in defiance of Congress. Given Art. I, §8, cl. 8 then there is more than the mere possibility that a question of federal law arises sufficient to satisfy the "arising under" jurisdictional authorization of Article III. Given that Congress has spoken, the United States Supreme Court should consider to exercise its supervisory power [*Marbury v. Madison*, 1 Cranch 137, 177 (1803)].

BASIS OF FEDERAL JURISDICTION IN THE COURT OF FIRST INSTANCE

Federal jurisdiction is authorized by Article I, §8, cl. 8, and Article III, Article VI, the 5th and 14th Amendments, and 35 U.S.C. §145, §146, and §306.

In Application Serial Number 07/371,937 ("the '937 application"), Notice of Appeal to the United States Court Of Appeals For The Federal Circuit was made on 10/14/99 which the Board of Patent Appeals and Interferences held in Appeal No. 94-2921. In its Decision regarding 00-1107, on 11/8/00, the court of appeals affirmed the Board's decision for putative lack of enablement under 35 U.S.C. § 112, ¶1, and indefiniteness under 35 U.S.C. §112, ¶2.

In Application Serial Number 07/760,970 ("the '970 application"), Notice of Appeal to the United States Court Of Appeals For The Federal Circuit was made on 10/26/99 after the final Decision (6/22/99) which the Board of Patent Appeals and Interferences held in Appeal No. 94-2920. In its Decision regarding 00-1108, on 11/8/00, the court of appeals affirmed the Board's decision for putative lack of operability or utility under 35 U.S.C. §101 and lack of enablement under 35 U.S.C. §112, ¶1.

[The Notation herein is to the Petitioner's original specification (OS) to the Patent Office, the Appeal Brief to the Board of Patent Appeals and Interferences (APB), Board Decision (D), and the Appendix was submitted with the Appeal Brief in the US Court of Appeals For The Federal Circuit (A). The Appendix for '937 was submitted with case 00-1107. The Appendix for '970 was submitted with case 00-1108.]

CONCISE STATEMENT OF MATERIAL FACTS

Petitioner ["Applicant"], Mitchell Swartz, ScD, MD, EE is a U.S. citizen and inventor who filed two patent applications claiming invention of a method to monitor the loading of hydrogen (a fuel) into palladium (a metal) in the same way that a sponge fills with water and a method involving changing that loading by a two-step method. These patent applications [S.N. 07/371,937 and S.N. 07/760,970 are the subject matter of this Petition.

S.N. 07/371,937 ("the '937 application") is a method, generally speaking, for easy monitoring of hydrogen loading which uses a vibration of the loaded metal. The original specification and claims solves the long-standing problem of monitoring the fuel within the metal remotely and non-invasively. This is of great utility because in the past it was necessary to mechanically interrupt the electrical circuit and then to physically move and weigh the loaded metal. Previously, such cumbersome invasive monitoring was complicated, took several minutes, and required uncoupling the electrical circuit "thereby not only stopping the reaction, but also cross-contaminating both the cathode and the laboratory" (A164). In '937, means are provided to vibrate the loaded metal which is then monitored to reveal information about its weight and, therefore, the quantity of fuel loaded into the material.

Claim 32 (Appendix E) claims monitoring the material, using at least one vibrational mode (natural frequency) which is the subject matter constituting the invention. The original specification and Claims 32-43 complied and conformed with the Patent Act by teaching the subject matter defined by each of the rejected claims, including the vibrational cathode (A166-A167), monitoring subsystems (A168-A170), viscosity, damping, surface materials (A169), and coupling to a large mass, and then set forth the best mode contemplated (***-1).

(*** -1) Appendix H shows a fast fourier transform (FFT) spectrogram of vibrations of one actual device, using the teachings of '937. The figure is from an article in a journal, peer-reviewed by those familiar with the state-of-the-art at the time the present original specification and claims were filed.

The invention '937 conforms to known physics (A170-A173) and has been shown to be operable using the teachings of the original specification and claims. Petitioner's Declarants have affirmed definiteness and utility.

S.N. 07/760,970 ("the '970 application") is a two-stage method to control loading. Claim 25 (Appendix E) claims a two-stage method using a first stage of electrode loading, followed by, a second stage of sudden rapid ("catastrophic") flow of the loaded hydrogen within the metal. Petitioner taught in the original specification and claims how this apparatus works and presented objective detailed evidence and experimental data of the invention. Specifically, Petitioner taught about loading [Claim 25, lines 2 and 3] on pages OS 15-16, 19, 20, 21, 22, 24, 27, 28, and 34 in the original specification, and on pages 5-6, 11, 13-14, 16, 19, 28, 42-45,48-50,55, 61, 65-67,70, 72, 78, 91, 95-98, 106, 110, 113, 115, 119-126, 128, 130, 133, 135-136, and 143 of the Appeal Brief before the Board. Petitioner taught about generating movements of isotopic fuel in the loaded metal ["flux", claim 25, lines 1, 4, 5] on pages OS 15-16, 19, 20, 21,22, 24, 27, 28, and 34 in the original specification, and on pages APC 5, 10-11, 6, 43, 45-46, 54, 65-68, 71-73, 98, 116, 119, 123, 134-136, and 139-141 of the Appeal Brief before the Board.

REASONS FOR GRANTING THE WRIT

I

Briefly, the gravamen of this case is that The Office has not properly followed its own standards of review regarding patentability, has shown abuse of discretion, and has failed to comply with previous Orders by the Board for a response to said Declarants regarding material matters of fact (operability and utility).

In '937 and '970, the putative "lack of operability" under 35 U.S.C. §112, ¶1 and "lack of utility" under 35 U.S.C. §101 has only been made by ignoring the original specification and claims by ignoring the timely-submitted unrebutted Declarations, by ignoring scores of Exhibits and references, and by ignoring the Office's own rules, thus creating an

arbitrary standard of review for patentability. In '937, the putative "indefiniteness" under 35 U.S.C. §112, ¶2 has only been made by ignoring the reasoning of several decisions , the Office's own rules, and what those who were skilled-in-the-art at the time the original specification and claims were filed have stated [*In re Morris*, 96-1425 (Fed Cir, 18 Aug 1997)] in unrebutted Declarations [*In re Marzocchi* (439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971)] produced as required [*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)] which fully addressed all matters criticized by the Office regarding matters of fact.

1. The Office has not provided any reason to doubt the objective truth of any of the Declarants' statements relied on for enabling support. No basis exists for a rejection under either section 112, ¶1 for operability lack of enablement or section 101 for lack of utility [*Environtech Corp. v. Al George, Inc.*, 730 F.2d 753, 762, 221 USPQ 473, 480 (Fed. Cir. 1984)].

2. Furthermore, the Office and the court of appeals have made no mention of exactly why substantive evidence in the form of Declarations in the record regarding matters of fact have not been substantively addressed.

3. In addition, the Office and the court of appeals have made no mention of why five Orders by the Board [with authority pursuant MPEP §1211] explicitly requiring a response to these relevant Declarations regarding material matters of fact (operability and utility) were ignored. One remand stated, "Further, the examiner should explain why these 'filings' and 'references' are inadequate in evidentiary weight, to overcome the evidence proffered by the examiner."

4. This Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (1972)], but the Office has ignored its own standards.

5. It is submitted that if the Office must rely upon reference to art cut of a cloth not even made from the original specifications and claims, and must systematically ignore unrebutted duly-submitted Declarations, then the Office's position must indeed be rather weak – which must dictate allowance of the present inventions.

II

This case has great and compelling importance when measured by either the particular constitutional mandate of Art. I, §8, cl. 8 or the number of people dependent upon energy monitoring, efficiency and utilization. The Office has not provided any authority for which it has ignored the fact that Congress has "encourage(d) progress" [*Diamond v. Chakrabarty*] , encouraged ingenuity [447 U.S. 303, 309] and has defined patentable statutory subject matter to include "anything under the sun that is made by man." [S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)] which must include inventions involving energy efficiency and material monitoring.

This case also involves important issues which resolve important questions separate from the merits of the case, and if necessary is also submitted under the collateral order doctrine [28 U.S.C. §1291; also *Cunningham v. Hamilton County, Ohio,* 119 S. Ct. 1915 (1999)].

QUESTIONS PRESENTED

1. Whether the Office has replied to duly-submitted unrebutted Declarations with conclusive effect regarding issues of material fact.

I

The decisions reject the reasoning of *Ex parte Porter* [25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992)] because they are inconsistent with, and do not address the facts averred in timely-submitted unrebutted Declarations (***-2). Petitioner submits that the Office has ignored, and failed to reply to, more than a dozen duly-submitted Declarations containing substantive rebuttal evidence [*In re Marzocchi*]. These had conclusive effect regarding issues of material fact,

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(***-2) In '937, the unrebutted Declarations are in the record at A8, A12, A18, A44, A49 ,A62, A66, A72, A74, A77, A85 [Appeal Brief, 00-1107]. In '970, the unrebutted Declarations in the record at A8, A12-A23, A32-A39 [Appeal Brief, 00-1108]. They are itemized in Appendix F.

Many were filed before the Final Notice of Appeal, and others were included with the Appeal Briefs to the Board of Patent Appeals. The Office received these Declarations, as proven by the Office's date-stamps, and as confirmed by the five remand Orders (A82-A89) by the Board to the Office for a response to the relevant Declarations on these very matters of fact.

and were put forward by Petitioner as required [*In re Oetiker*]. In '937, the unrebutted Declarations [A8, A12, A18-A43, A44-A48, A49, A62, A66, A72, A74, A77, A85] confirm definiteness and utility as defined by claim 32, substantially and fully [*In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980)]. In '970, the unrebutted Declarations [A8, A12-A23, A32-A39 [Appeal Brief, 00-1108] confirm operability and utility as defined by claim 25, substantially and fully [*In re Gazave; In re Chilowsky; In re Jolles*]. The Declarations demonstrate validation of the Applicant's claimed subject matter and therefore enablement.

Petitioner's Declarants [Appendix F], skilled-in-the-art at the time the original specifications and claims were filed, have probative value because they are scientists, researchers, editors, and a Patent Examiner and thus are authorities. The unrebutted Declarations fully addressed and contradicted all matters of fact -- operability, utility and definiteness. The Declarants affirmed that the invention operates as stated, was correctly taught in the original specification and claims, and that a person of ordinary skill-in-the-art would have understood the inventor to have been in possession of the claimed invention at the time of filing. Nothing has been presented which differs or rebuts the Declarations [or the *amicus curiae* Briefs of Drs. Chubb, Mallove, Fox, and Mr. Valone]. The Office has not indicated any controlling authority to change its standards of review mandated for unrebutted substantive Declarations regarding material issues of fact.

II

The decisions reject the reasoning of other Appeals Court in *Marino v. Hyatt Corporation*, 793 F.2d 427, 430 (1st Cir. 1986), *Morrill v. Tong*, 390 Mass. 1207 129 (1983), *Chelebda v. H.E. Fortuna & Brothers Inc.* 609 F.2d 1022 (1st Cir. 1979) by ignoring the unrebutted sworn Declarations despite being Obligated to assume that the unrebutted Declarations are true [*Lewis v. Bours*, 119 Wn.2d 667, 670, 1992]. The Declarants have been ignored because they refute the Office's unsupported position and prove definiteness in '937, and utility and operability in '970. Only by ignoring the Declarations can the Office purport

that a material cannot "vibrate" ['937] and that there is no "loading" ['970].

III

1. The decisions reject the reasoning of *Ex parte Gray* [10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989)] because there was evidence of definiteness in '37 and operability and utility in '970 and '937, beyond the detailed specifications, in the form of corroboratory expert testimony including unrebutted Declarations and *amicus curiae* Briefs. The Office and the decisions should have indicated which, if any, of the averments in the Declarations were formally considered and, if so, how they reached their conclusion or <u>how</u> the Declarations failed to overcome the purported *prima facie* case initially established by the Office. Simply put, it cannot be determined from the record which -if any- of these submitted averments by the Declarants and *amicus curiae* regarding definiteness, operability and utility have been formally considered by the Court.

2. The decisions reject the reasoning of *In re Morris* because the interpretation of definiteness, operability, and utility are predicated upon that which one who is skilled-in-the-art would reach, requiring comment upon the statements made by the probative Declarants and *amicus curiae*. Petitioner has the right to expect that proffered Declarations be read, and unrebutted Declarations be respected as they did fully address <u>all</u> matters criticized by the Office. The decisions have erred by omitting exactly why this factual, substantive and engineering evidence in the record regarding definiteness has not been addressed.

IV

The failure to respond violates the Office's own rules and five remand Orders (e.g. A82-A89) by the Board to the Office for a response to the relevant Declarations on these very matters of fact. The Office has also ignored five Orders by the Board explicitly requiring a response to these relevant Declarations. At least one remand explicitly stated, "Further, the examiner should explain why these 'filings' and 'references' are inadequate in evidentiary weight, to overcome the evidence proffered by the examiner." The 'filings' included the Declarations. Attention is directed to the fact that the Board had the authority to Order the Office to substantively respond pursuant to MPEP §1211, but the Office

has not responded with specificity and substance as the Board ordered. Similarly, the Office and decisions have not stated this has been simply ignored.

2. Whether the Office complied with its own Rules regarding MPEP 707.07(j) and 706.03(d).

I

In '937, Claims 32 through 43 stand rejected pursuant to 35 U.S.C. 112, ¶2 for indefiniteness. However, this rejection is not unreasonable. Petitioner (then Applicant), *pro se*, requested "constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)]". The next substantive response received was the Final Rejection, which was accompanied by constructive suggestions.

To comply with the Examiner, the claims were rewritten using the minor changes that the Examiner had recommended by telephone and by written communication. All changes were made per, and did conform to, the Examiner's own suggestions. The changes were trivial. The wording and scope of the rewritten claims was composed in the language of the specification and claims of the original disclosure, did not raise new issues or contain any new matter, and made no new claim limitation.

As discussed with the Examiner and as fully discussed in the Appeal Briefs before the Board (2/28/94), they contained the precise suggestions which examiner stated would overcome said definite rejection. The final proposed claims were immediately submitted for entry pursuant to MPEP 707.07(j) and MPEP 706.03(d), and Applicant provided substantive rebuttal evidence before the Notice of Appeal [*In re Marzocchi*] including Declarations as required [*In re Oetiker*].

As the Federal Court admits:

> **"Appellant gave substantive arguments for entry including specific and substantial arguments against the rejection."**

II

The final proposed claims were not entered as they have been for other applicants and as should be accepted by the standards of review regarding patentability. As the *amicus curiae* Brief of Thomas Valone (Integrity Research Institute, Washington, DC; former Patent Examiner) has stated,

> "it needs to be noted that the suggestion of the examiner to add language to these two claims in order to overcome the rejection under 35 USC 112 second paragraph and then following with a refusal to enter the exact language suggested because of a "new matter" or "new issue" accusation amounts to not dealing honestly with the appellant and not the type of behavior that is normally endorsed by the Patent Office. It also does not "help our customers to get patents" as in the present Office motto. From my experience at the Patent Office such deception of an applicant on the part of the examiner was never tolerated by a supervisor."

III

As a result, the Office has not complied with the requirements of MPEP 707.07(j) and 706.03(d), and has rejected the reasoning of the Supreme Court that a *pro se* litigant is entitled to less stringent standards [U.S. Rep, 404, 520-521 (1972)] especially because in this case, the Office has not followed its own standards.

The Petitioner is entitled to an impartial tribunal [28 U.S. Code Section 144, *Mayberry v. Penna.,* 91 S.8.; *Bloom v. Illinois,* 88 Ct. 499 S.Ct. 1477; *Duncan v. Louisiana,* 88 S.Ct.1444] and equal protection of the laws and fair application of the standards of review. The refusal to enter the exact language in Amendments (A187) suggested by the Examiner to overcome indefiniteness, when said amendments added neither new matter nor issues, and could not have been offered before the receipt of suggestions pursuant to MPEP 707.07(j) and 706.03(d), and which responded to, and adopted, each suggestion made by the Examiner (A85-A90, A124-131, also A83-A84) is unfair.

3. Whether the Office complied with the standards of review regarding definiteness under 35 U.S.C. §112 ¶2.

I

For '937, the Office has purported "indefiniteness" of the claims under 35 U.S.C. §112, ¶2. Petitioner submits that this is not true according to the preexisting standards for review, and because the initial rejection of Claims 32 and 35-41 over Johnson under 35 U.S.C. 102 could not have been made and could not have been sustained through the Final Rejection, had the invention truly been without definiteness (***-3). Also ignored, and as important, the Claims were developed after the precise suggestions which the Examiner stated would overcome said rejection pursuant to 707.07(d).

II

1. The decision rejects the reasoning of *Ex parte Gray* because in '937 there is evidence of definiteness in the form of expert testimony from Drs. Chubb, Mallove, Fox, Bass, Swartz and Mr. Straus (A44-A48), Rotegard, and Valone with substantial argument [*In re Marzocchi, In re Oetiker*]. The Declarants with probative value fully addressed all matters criticized by the Office regarding definiteness (A90-A99), substantially and extensively [*In re Gazave; In re Chilowsky; In re Jolles*]. They prove that a person of ordinary skill-in-the-art would have understood the Petitioner to have been in possession of the claimed invention at the time of filing, and demonstrate that

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(***-3 - According to *In re Hammack* [427 F.2d 1384 n.5, 166 USPQ 209 n.5 (CCPA 1970)] "...indefiniteness in claim language is of semantic origin". Definiteness is the opposite of indefiniteness, and under 35 U.S.C. 112 ¶2, definiteness is that characteristic of a patent claim in which claim language makes the scope of the claim clear to a person skilled in the art to which the invention pertains [MPEP 2173, MPEP 2173.02, MPEP 2173.05(a)]), in light of the specification.

As a judicial test, "invention" - i. e., "an exercise of the inventive faculty," *McClain v. Ortmayer*, 141 U.S. 419, 427 (1891) - has long been regarded as an absolute prerequisite to patentability [*Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U.S. 42 (1935); *Sharp v. Stamping Co.*, 103 U.S. 250 (1880); *Hotchkiss v. Greenwood*, 11 How. 248 (1851)], and in 1952 that Congress, in the interest of "uniformity and definiteness," articulated the requirement in a statute, [425 U.S. 219, 226] framing it as a requirement of "nonobviousness." [*Dann v. Johnston*, 425 U.S. 219 (1976) 425 U.S. 219 No. 74-1033]

the original specification and claims were precise, clear, correct, and unambiguous [pursuant to MPEP 2173.05(a)].

2. The decision rejects the reasoning of *In re Morris* [and *Ex parte Porter*] because definiteness must be predicated upon that which one who is skilled-in-the-art would reach. The Office, like the Court, is Obligated by law to assume that such Declarants' unrebutted assertions on the relevant factual statements are true [*Lewis v. Bours*], but has not. Nothing has been presented which differs or rebuts the Declarations. It must be reasonably concluded that the Declarations remain ignored in their factual, substantive content because they precisely refute the Decision's incorrect statements and erroneous conclusion.

III

1. The decision rejects the reasoning of *In re Prater* [415 F.2d 1393, 162 USPQ 541 (CCPA 1969)] because pending claims must be given the broadest reasonable interpretation consistent with the original specification claims and not cut of cloth of other art. Simply put, the claimed invention must be the focus of the definiteness requirement as this Court has found.

> **"Respondents' claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis."**
>
> [Diamond v. Diehr, 450 U.S. 175 (1981),
> 450 U.S. 175, No. 79-1112, 3/3/81]

Amicus curiae Valone has stated,

> "10. Clearly, one of the most important points regarding Office rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, is that the claimed invention should be the focus of the utility requirement. "Each claim therefore, must be evaluated on its own merits for compliance with all statutory requirements" (MPEP 2107.01, I.). In this case on appeal (00-1107), claim 32 claims a method for monitoring, with three method steps (mechanically coupling, exciting said vibration, and following the frequency) that can be easily understood to persons with normal engineering skill in any art."

Attention is directed to the fact that the Office has systematically refused to accurately discuss the invention as taught in the original specification and claims - to wit, a vibrator to monitor loading. Instead, the Office has fabricated "indefiniteness" along with its fabrication of, and attack upon the words "excess heat", which were not even mentioned in '937.

2. The decision rejects the reasoning of *Ex parte Ionescu* [222 USPQ 537, 539 (Bd. App. 1984)] because if there were another basis for indefiniteness not addressed, then the Examiner was Obligated to have further explained what the rejection was.

3. Rule MPEP 707.07(g) specifically requires that the Office must give a "full development of reasons" why its use of "excess heat", not even mentioned in either the original specification or claims, makes the present invention indefinite. It has not. The Office has failed its own standards of review because by its own rules, it was Obligated to provide reasons why the terms in the claims and/or scope of the invention are unclear "in a positive and constructive way, so that minor problems can be identified and easily corrected, and so that the major effort is expended on more substantive issues".

IV

The decision rejects the reasoning of *Atmel Corp. v. Information Storage Devices Inc.* [Fed. Cir., No. 99-1082, 12/28/99] because in '937 definiteness has been absolutely corroborated by peer-reviewed publications by the Petitioner [including those in *Fusion Technology,* published by the American Nuclear Society] which demonstrate acceptability of the claim language by those of ordinary skill-in-the-art.

V

1. The decision rejects the reasoning of the decision in *Seattle Box Co., v. Industrial Crating & Packing, Inc.* [731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984)] because imprecise claim language may not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph [2173.05(b)] .

2. The decision rejects the reasoning of *In re Zletz* [893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)] because the specification clearly and explicitly stated the meaning of the

terms in the claims. As Petitioner argued, the words were defined and were fully-discussed in the original specification and the cited art. Most importantly, the claims of '937 were definite after the precise suggestions examiner stated would overcome said rejection. Corroborating this, the Examiner used these words for more then a decade without any trouble -- until the matter was invented "tongue in cheek" *nunc pro tunc*.

3. The decision rejects the reasoning of *In re Wands* [858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed.Cir.1988)] because Petitioner fully complied with the definiteness requirement of 35 U.S.C. §112. The original specification of '937 and Claims 32-43 complied and conformed with the Patent Act. They taught the subject matter defined by each of the rejected claims, set forth the best mode contemplated, and distinctly point out and claim the subject matter which constitutes the invention.

VI

1. The Office has ignored its own Rules. As discussed by Examiner Valone in his *amicus curiae* Brief, there was definiteness because the preamble of claim 32 recites the purpose of the process, the body of the claim does not refer back to the preamble, and the process steps are able to stand alone (pursuant MPEP 2111.02). The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite.

2. Claims 32, 38, 40, and 35 do not even mention "nuclear" in the preamble. The rejection of those claims based upon the other art cited by the Office demonstrates the Office's bias because there can logically be no such arguments by the Office. As *amicus curiae* Valone has stated,

> "14. Regarding the extensive argument about cold fusion, (App. Bd. p. 12-26), it is important to note that claim 32 does not have anything to do with cold fusion, nuclear fusion, nor "excess heat." Therefore, such arguments on the part of the Appeals Board is irrelevant and perhaps an effort at obfuscation based on the prevailing Patent Office management attitude toward any reference to "cold fusion."

VII

3. *Amicus curiae* Valone (former Patent Examiner) has stated,

> "15. To illustrate, the METHOD OF MONITORING a heartbeat was used centuries before it was even known what a heartbeat consisted of. Therefore, it is not logically necessary for either party in this case to argue the merits of cold fusion as it was known in 1989. The appellant is simply claiming a METHOD FOR MONITORING the loading of an electrode, which appears to be very similar to but distinct from Johnson."
>
> "16. To clarify further, a METHOD FOR MONITORING a disease does not become useless if there is no disease that can be found. The Appeals Board is arguing as if the inventor must prove that the disease exists, which makes no logical sense in the case of claim 32.
>
> "17. Claim 32, which does not suffer from any justified rejection at this time, should be allowed to mature into a patent."

4. Whether the Office complied with the standards of review regarding operability under 35 U.S.C. §112 ¶1.

I

In '970, the Office has made an improper and reversible rejection under 35 U.S.C. §112 ¶1 for purported lack of operability because the Office has not complied with the standards of review for patentability with respect to resolving operability. The Office has ignored both the original specifications and claims and submitted Declarations (Appendix F; ***-4) which have provided evidence of operability. As a result, the decisions are inconsistent with, and reject the reasoning of, many other Court decisions.

***-4 These unrebutted Declarations were timely received, as confirmed by five Remands with Orders to the Examiner to respond (e.g. A82-A89).

II

The decision rejects the reasoning of *In re Hogan* [559 F.2d 595, 60S, 194 USPQ 527, 537 (CCPA 1977)] because Petitioner's exhibits [Appendix G] included published confirmations of the teachings taught years earlier in the original specification and claims. These prove that Petitioner was correct on the filing date of the application. Each and every technology, pertaining to each line of Claim 25, has passed peer-review by those skilled-in-the-art - and thus has achieved validation.

In Claim 25, lines 2 and 3, Petitioner claimed how to load the hydrogen ["fuel"; discussed on pages OS10, 17, 19, 29, 32, and 34 of the original specification, also APB5-6, 11, 13-14, 16, 19, 28, 42-45, 48-50, 55, 61, 65-67, 70, 72, 78, 91, 95-98, 106, 110, 113, 115, 119-126, 128, 130, 133, 135-136, and 143]. This loading technology, consistent with conventional physics, has since been published in peer-reviewed journals [e.g. Swartz, M., *Fusion Technology*, 22, 2, 296-300, 1992; Swartz, M., *Fusion Technology*, 26, 4T, 74-77, 1994; Swartz, M., *Fusion Technology*, 32, 126-130, 1997]. Therefore, supplying and loading a material with an isotopic fuel is not unproven "theory" or "incredible", as the Board's eleven page Answer purports (A128), but can be elicited using the teachings of the original specification and claims (***-5).

In Claim 25, lines 1, 4, 5, Petitioner claimed how to create a flow (flux) of the loaded material after loading [discussed on pages OS15-16, 19, 20, 21, 22, 24, 27, 28, and 34 of the original specification; also APB5, 10-11, 6, 43, 45-46, 54, 65-68,71-73, 98, 116, 119, 123, 134-136, and 139-141]. This diffusion technology, consistent with conventional physics, has since been published in peer-reviewed journals [e.g. *MIT RLE Progress Report*, P. Hagelstein, M. Swartz, 139: 1, 1-13 (1997), Swartz. M., 1994 Vol. 4. "*Proceedings: ICCF4*", sponsored by EPRI and the Office of Naval Research, and Swartz, M., 1997, *Journal of New Energy*, 1, 4, 26-33, Swartz, M, 1998, *Transactions*

(***-5) As the *amicus curiae* Brief of Hal Fox (Editor, Fusion Information Center, Inc., Utah) states, " ... there are a variety of lattice structures ... that can be "loaded" ..". The *amicus curiae* Brief of Scott R. Chubb, Ph.D (Research Physicist, Washington, D.C.) states, "... in 1991 ... during this time, it became apparent that the loading of deuterium into palladium (Pd) was playing a critical role ..."

of the American Nuclear Association, Nashville, Tenn ,1998 Meeting, (ISSN:0003-018X publisher LaGrange, Ill) 78, 84-85]. Therefore, internal diffusion of isotopic fuel can be elicited using the teachings of the original specification (OS-Figs.13,14;A104-A105) and claims (***-6).

Therefore, this two-step method should be patentable based upon opinions of this Court.

> **"Transformation and reduction of an article "to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines."**
>
> [Gottschalk v. Benson, 409 U.S. 63 (1972), 409 U.S. 63, No. 71-485]

> **"Industrial processes such as this ["a physical and chemical process (which involves) the transformation of an article .... into a different state or thing"] are the types which have historically been eligible to receive the protection of our patent laws. [450 U.S. 175, 185]"**
>
> [Diamond v. Diehr, 450 U.S. 175 (1981)]

III

1. The decision rejects the reasoning of *Ex parte Gray* [10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989)] because there was evidence of operability in the form of unrebutted expert testimony from Petitioner's Declarants (A18,A44,A49,A62,A66,A72,A74,A77,A85) and others (A10-A21; A4-A36; A90-A116; A75,A78-A80) [cf. Appendix G and *amicus curiae* (***-7)]. Petitioner's Declarants corroborate operability and that '970, a two-stage method of the controlling loading [A140, A193] with four method steps to control that loading, was taught in a form that can be easily understood to persons with normal engineering skill in any art. They prove that, as of the filing date, scientists skilled-in-the-art consider loading, diffusion, and flux to be

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(***-6) As *amicus curiae* Chubb has stated, "... each deuterium nucleus (D) may effectively dissociate from its electron and freely flow through the metallic substrate."

***-7) The Declarations were also supplemented with relevant Exhibits from the US Navy, US national laboratories, NASA, CEREM, SRI, EPRI, and many other scientific and research organizations.

real and to have been taught correctly in the original specification and claims.

2. The decision rejects the reasoning of *In re Morris* [also *Ex parte Porter*] because the interpretation of an issue of fact, like operability, must read on the original specification and claims 25-48 and be predicated upon the Declarations (A10, A21-A36;A37-A116) to a conclusion consistent with what one who is skilled-in-the-art would reach. The Declarants have fully addressed all matters criticized by the Office regarding operability, substantially and extensively [*In re Gazave; In re Chilowsky; In re Jolles*]. Nothing has been presented which differs or rebuts the Declarations.

3. The decision rejects the reasoning of *Marino v. Hyatt Corporation, Morrill v. Tong, Chelebda v. H.E. Fortuna & Brothers Inc.* 609 F.2d 1022 (1st Cir. 1979) by ignoring the unrebutted Declarations despite being Obligated by law to assume that such Declarants' unrebutted assertions (A10, A21-A36;A37-A116) are true [*Lewis v. Bours*] with response to a conclusion consistent with what one who is skilled-in-the-art would reach.

IV

1. The decision rejects the reasoning of *In re Wertheim* [541 F.2d at 263, 191 USPQ at 97] because the Office failed to present "evidence or reasons why the Declarants, skilled-in-the-art, would not recognize in the disclosure a description of the invention defined by the claims" (***-8). Instead, the Office's decision and notions are fabricated without any substantive underlying factual inquiries [*Johns Hopkins Univ. v.Cellpro, Inc.*, 152 F.3d 1342, 1353, 47 USPQ2d 1705, 1713 (Fed.Cir.1998)] about the present invention - and

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***-8 The Declarants are ignored regarding their factual evidence and engineering content because they precisely refute and contradict the Office's statements and opinion (e.g. A90-A99; *amicus curiae* Brief of Dr. Eugene Mallove). The Declarants thus demonstrate operability and utility (*infra*), and enablement (a matter of law). It cannot be determined from the record which - if any - of these unrebutted facts regarding operability have been formally considered. The Office (and the decision) should have indicated which, if any, of the averments in the Declarations were formally considered and, if so, how they reached their conclusion.

are made solely from cloth cut of other art. Instead, the decision is void of any discussion whatsoever of any of the Declarations on any of matter of operability. No mention is made of why this evidence in the record proving operability, and supporting Applicant, has not been addressed.

2. The decision rejects the reasoning of *In re Brana* [51 F.3d at 1566, 34 USPQ2d at 1441] and *In re Marzocchi* because the Office cannot a dual rejection (utility and operability) unless it has reason to doubt the objective truth of the statements contained in the written description because these are questions of fact [*In re Brana; In re Eltgroth*, 419 F.2d 918, 164 USPQ 221 (CCPA 1970)]. Petitioner's Declarants [A4-A9, A10-A36; confer also witnesses at A75, A78-A80 and *amicus curiae* Briefs] prove that Applicant was correct on the filing date of the application [*In re Hogan*] to one skilled-in-the-art [*Atmel Corp. v. Information Storage Devices Inc.*].

3. The decision rejects the reasoning of *In re Oetiker* because the Office failed to present a *prima facie* case of unpatentability. Nothing has been presented which differs or rebuts Petitioner's Declarants, who did fully address all matters criticized by the Office regarding operability. No reason exists to doubt the objective truth of the statements relied on, and therefore no basis exists for a rejection under either section 112, ¶1 for operability [*Environtech Corp. v. Al George, Inc.*]. Instead, the Office's unsubstantiated claim of lack of operability is solely based upon other peoples' work and outdated and inaccurate notions. As such there has been no compliance with the preexisting standards for review for patentability with respect to resolving operability by the Office.

(***-9) As the *amicus curiae* Brief of Thomas Valone (Integrity Research Institute, Washington, DC; former Patent Examiner) has stated, "13. Regarding the rejection under 35 USC 112 second paragraph, the App. Bd. also apparently erred when they sustained it to both claim 32 and claim 42. Upon reviewing the disclosure of the case, (Serial No. 07/371,937) and the Appeal Brief (11/28/92, p. 26), it is clear that the rejection only was applied for lack of antecedent basis of "said material" in claim 42. The use of "said material" in claim 32 has sufficient antecedent basis in the preamble of claim 32. Therefore, the rejection under 35 USC 112 second paragraph does not and should not apply to claim 32 at all.

V

1. The decision rejects the reasoning of *In re Prater* [415 F.2d 1393, 162 USPQ 541 (CCPA 1969)] because pending claims must be given the broadest reasonable interpretation "to thereby interpret limitations explicitly recited in the claim" consistent with the specification (*** -9). The Office has been inaccurate and instead of addressing the invention as it was actually taught in the original specification and claims, the Office has solely relied upon reference to art cut of a cloth other than the original specifications and Claims 25-48. This is not proper because the invention (structure, operation and composition) is defined by the Claim 25 and the original specification. The vibrator of '937 and the two-step method of '970 must be the focus of the operability requirement. As *amicus curiae* Valone has stated,

> "Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading the limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim"- *In re Prater*."

2. The decision rejects the reasoning of *In re Ziegler* [992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993)] because the notion that the written description fails to illuminate a credible operability can only be made, by not reading on the claims of this patent regarding a two-stage method. However, it is below the standards of review to solely use cloth cut of other art because the invention (structure, operation and composition) is defined by the claims and the original specification. This leading away from the actual original specification and claims by the Office, and fabrication of "*excess heat*" in '937, herald bias by the Office rather than proper application of the standards of review.

3. The decision rejects the reasoning of *Newman v. Quigg* [877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989)] because the Office derides the present invention with reference to cold fusion but, in fact, Claim 25 is a method for a two-stage method involving loading of hydrogen into a specialized metal electrode and has nothing to do with perpetual motion. Such (well-known) "boilerplate" attacks by

the Office on the words "*cold fusion*" is well-known [confer Bass, Rotegard, and Mallove Declarations, and the Valone, Fox, and Mallove *amicus curiae* Briefs]. As the *Amicus Curiae* Brief of Eugene F. Mallove, Sc.D (Editor, New Energy Research Laboratory, NH) has stated,

> "6. The most notable characteristic of the attack against the Swartz patent application at hand is its stale fixation with misrepresented events of 1989, its citation of erroneous reports, and its continued argument from supposed authority, rather than from evolved science and meticulous experiment."

VI

1. The decision is inconsistent with Office rule MPEP 2107.01 because the previous rejection of claims 25-32, 35, 41-43, and 46 pursuant to 35U.S.C.102, and claims 25-48 pursuant to 35U.S.C.103 could not have been made and sustained through a final rejection had the invention truly been inoperative and lacking utility. No prior patented art can be found for something that clearly does not operate and has no utility, and the fact that claim 25 was found by the examiner to be anticipated by Rabinowitz shows that the Petitioner's invention must have made at least one credible assertion of specific utility to satisfy 35 U.S.C.101 and 35 U.S.C.112.

2. The decision is inconsistent with MPEP 2111.02 because any question of operability regarding claims 25, 27 and 46 can logically only refer to the preamble "In a process for producing a nuclear fusion product from an isotopic fuel using a material," which does not carry patentable weight in this claim. The preamble of claim 25 recites the purpose of the process. The body of the claim does not refer back to the preamble but deals with diffusion flux, and most importantly the process steps are able to stand alone. Therefore, claims 25, 27 and 46 can be asserted to have justifiable operability.

3. The decision is inconsistent with MPEP §1211 because the decision also ignores, and therefore rejects without explanation, the reasoning of the Board's judges Ordering the Office to remedy the failure of the Office to substantively respond to the Declarations which give conclusive effect regarding operability. The Board had the authority to do so

pursuant MPEP §1211. The Office has not responded with specificity and substance as the Board ordered. It is egregious that the Remand Orders from the Board remain substantively ignored despite remand Orders requiring a reply to the Declarations which prove operability.

VII

In '970, the decision rejects the reasoning of *In re Wands* [858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed.Cir.1988), citing with approval *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986); also *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)] because Petitioner has fully complied with the operability requirement of 35 U.S.C. §112, ¶1. Petitioner's original specification and Claims 25-48 [A193] taught the subject matter defined by each of the rejected claims, set forth the best mode contemplated with an adequately written description of how to operate the invention, so that an artisan or those skilled-in-the-art, could practice it without undue experimentation, and distinctly pointed out and claimed the subject matter which constitutes the invention. These teachings were precise, clear, and unambiguous to a person skilled in the art, and adequately presented so that an artisan could practice it without undue experimentation [cf. Declarations A18, A44, A49, A62, A66, A72, A74, A77, A85, and *amicus curiae* Briefs]. Petitioner has far exceeded all requirements.

VIII

What is in dispute is whether the Petitioner's original specification and claims shall be accurately and precisely addressed pursuant to the standards of review for patentability, or if the Office can reject the reasoning of other Courts, its own rules, and said standards of review.

Petitioner's original specification '937 and Claim 32 demonstrate enablement (a question of law, *In re Fouche* [439 F.2d 1237, 1243, 169 USPQ 429, 434, (CCPA 1971)]) about a method to monitor [Appendix H] which is understood to one skilled-in-the-art [*Genentech Inc. v. Nova NordiskA/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997)]. The Office ignores the invention and the submitted material Declarations by those skilled-in-the-art, and solely responds to art cut of cloth made of other than the present invention.

Petitioner's original specification '970 and Claim 25 demonstrate enablement (a question of law, *In re Fouche* [439 F.2d 1237, 1243, 169 USPQ 429, 434, (CCPA 1971)]) about a two-stage method involving loading of deuterium into a specialized metal electrode, because it is understood to one skilled-in-the-art [*Genentech Inc. v. Nova NordiskA/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997)]. The Office ignores the invention and the submitted material Declarations by those skilled-in-the-art, and solely responds to art cut of cloth made of other than the present invention.

The Office has not cited any authority by which it can arbitrarily and capriciously apply non-uniform standards of review.

Petitioner has been willing to reveal to the public the substance of his discovery and "the best mode ... of carrying out his invention," 35 U.S.C. 112, and should be granted "the right to exclude others from making, using, or selling the invention throughout the United States," for a period of 17 years. 35 U.S.C. 154. In return, the federal patent system is supposed to encourage the creation and disclosure of new, useful, and non-obvious advances in technology and design in return for the exclusive right to practice the invention for a period of years [*United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 186 -187 (1933)].

Petitioner submits that if the Office must rely upon reference to art cut of a cloth other than this specification and claims, then their position must indeed be rather weak and dictate allowance of the present invention. In accordance with the foregoing arguments, Petitioner's original specification and claims has complied and conformed with the requirements of sections 112 of the Patent Act, and reversal of the final rejection of claims 25-48 is respectfully requested, as required by the statute (35 USC 112).

5. Whether the Office complied with the standards of review regarding utility under 35 U.S.C. §101.

I

Petitioner submits that the Office has made improper and reversible rejections under 35 U.S.C. §101 for purported lack of utility by systematically ignoring Declarations, submitted by Petitioner, obtained from those skilled-in-the-art, and as a

result, the Office has not followed the standards of review for patentability with respect to resolving utility [a matter of fact] and the decisions are inconsistent with other Court decisions. Title 35 U.S.C. 101 provides for the issuance of a patent to a person who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." [450 U.S. 175, 182]

The Declarants and witnesses state that the inventions have considerable utility heralding conformity with the requirements of §101. As *amicus curiae* Fox has stated,

> " .. the subject invention by Dr. Mitchell Swartz has considerable utility, not only for specific type of uses cited by Dr. Swartz, but also for a broader range of applications in both electrochemical operations and in experiments involving the handling of electrodes in some gaseous environments. The ability to determine the "loading" into an electrode by the means described by Dr. Mitchell Swartz is non-obvious, important, and useful."

35 U.S.C. 101 provides for the issuance of patents to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof ...". '937 has obvious utility to measure loading of metal and '970 has great utility as a two-stage method to control loading, as confirmed by the unrebutted Declarations.

II

The decisions reject the reasoning of *In re Irons* [52 CCPA 938, 340 F.2d 974, 144 USPQ 351 (1965) and *Ex parte Gray* because there was evidence of utility, beyond the detailed specifications and claims, in the form of expert testimony from the unrebutted Declarants (A18, A44, A49, A62, A66, A72,A74, A77, A85), *amicus curiae* [Drs. Chubb, Mallove, Fox, Bass, Swartz and Mr. Straus, Rotegard, and Valone], and others [A10-A21; A4-A36; A90-A116; also A75,A78-A80; confirmed by exhibits from the US Navy, US national laboratories, NASA, CEREM, SRI, and EPRI] which corroborate utility.

These witnesses who support the Petitioner include two of the Office's own witnesses, Drs. Rehn (United States Navy) and Dr. Will, who contradict the Office's biased notion.

> **"Perhaps the clearest scientific fact, at this time, is the hardest for physicists to accept: nuclear reactions apparently do occur in deuterium-loaded Pd, Ti, and probably in other solids."**
>
> [Rehn, V., Ahmad, I., Sci. Info. Bull., Off. US Naval Research Asian Office, NAVSO P-3580, 18, 1/'93]

III

The decisions reject the reasoning of *In re Brana* because the Office provided not one iota of evidence from anyone else skilled in the art to rebut any one of Petitioner's Declarants with specificity and substance. Instead, the submitted Declarations [and four *amicus curiae* Briefs] are ignored. No reason exists to doubt the objective truth of the statements relied on for utility, and therefore no basis exists for a rejection under either section 101 for utility [*Environtech Corp. v. Al George, Inc.*].

IV

The decisions reject the reasoning of *Standard Oil Co. (Indiana) v. Montedison* [S.P.A., 664 F.2d 356, 375, 212 USPQ 327, 344 (3rd Cir. 1981), *cert. denied*, 456 U.S. 915, 102 S.Ct. 1769, 72 L.Ed.2d 174 (1982)], *E.I. du Pont de Nemours & Co. v.Berkley & Co.* [620F.2d1247,1258 n.10,1260 n17,205 USPQ1,8n10,10n.17(8th Cir.1980)], *Krantz and Croix v.Olin* [148 USPQ 659, 661-62 (CCPA 1966)] and *Raytheon Company v.Roper Corporation* [U.S.C.A., Federal Circuit, 1983, 724 F.2d 951, 220 USPQ 592] because the present claimed invention meets at least one stated objective, and therefore utility under §101 is clearly shown.

V

1. The decisions are inconsistent with, and conflict with several of the Office's own rules. Attention is directed to the fact that these decisions are inconsistent with MPEP 2107.01 because the previous rejections pursuant to 35 U.S.C.102 of claims 25-32, 35, 41-43, and 46 over Rabinowitz in '970 and claims 32 and 35-41 over Johnson in '937 could not have been made and sustained through a final rejection had either of the inventions truly been inoperative and lacking utility.

As *amicus curiae* Valone has stated,

"4. .... it is well-known to those skilled in patent examining that no prior patented art can be found for something that clearly does not operate and has no utility. Specifically, the fact that claim 32 was found by the examiner to be anticipated by Johnson (Appeal Brief 07/371,937 - 11/28/92, p. 26) shows that the appellant's invention must have made at least one credible assertion of specific utility to satisfy 35 U.S.C. 101 and 35 U.S.C. 112 (MPEP 2107.01)."

2. No prior patented art can be found for something that clearly does not operate and has no utility. The fact that claim 25 was found by the examiner to be anticipated by Rabinowitz shows that the Petitioner's inventions must have each made at least one credible assertion of specific utility to satisfy 35 U.S.C.101.

As Valone has stated,

"6. Regarding the actual rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, and the App. Bd. Decision (p. 12), it is valuable to note that "where an applicant has set forth a specific utility, courts have been reluctant to uphold a rejection under 35 U.S.C. 101 solely on the basis that the applicant's opinion as to the nature of the specific utility was inaccurate" (MPEP 2107 I.) and "practical considerations require the Office to rely on the inventor's understanding of his or her invention in determining whether and in what regard an invention is believed to be 'useful'" (MPEP 2107 I.). In both instances, the App. Bd. has apparently disregarded the specific utility and the inventor's understanding of his invention."

"7. The Board of Appeals further performs a logical non sequitor when it starts the discussion of the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph with the word "incredible" on the first page (App. Bd. p. 12) of a fourteen-page discourse on utility. Rather it is specifically noted that "Office personnel should be careful not to label certain types of inventions as 'incredible' or 'speculative' as such labels do not provide the correct focus for the evaluation of an assertion of utility. 'Incredible utility' is a conclusion, not a starting point for analysis under 35

U.S.C. 101 (MPEP 2107.01, I.B) (emphasis in the original text)."

"11. By a process of elimination, the question of utility (App. Bd. p. 12-26) regarding claim 32 can logically only refer to the preamble "In a process...is electrochemically loaded," which however, does not carry patentable weight in this claim. To emphasize this fact more clearly, note:

(1) the preamble of claim 32 recites the purpose of the process,

(2) the body of the claim does not refer back to the preamble,

(3) the process steps are able to stand alone (MPEP 2111.02).

Therefore, claim 32 can be asserted to have justifiable utility when the preamble is put in proper perspective."

6. Whether the Office has violated the United States Constitution.

I

1. The Office has rejected the controlling authority of Art. I, §8, cl. 8 which provides that "Congress shall have Power (t)o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries". (***-10) Art. I, §8, cl. 8 empowers Congress in this matter.

2. Congress has mandated progress.

"The patent laws (reflect) this Nation's deep-seated .... need to encourage progress."

[Diamond v. Chakrabarty, 447 U.S. 303 (1980), 447 U.S. 303, No. 79-136]

***-10 "The patent laws promote this progress by offering inventors exclusive rights for a limited period as an incentive for their inventiveness and research efforts. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-481 (1974); *Universal Oil Co. v. Globe Co.*, 322 U.S. 471, 484 (1944). The authority of Congress is exercised in the hope that "[t]he productive effort thereby fostered will have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for our citizens." Kewanee, *supra*, at 480." [*Diamond v. Chakrabarty*, 447 U.S. 303 (1980) 447 U.S. 303 No. 79-136]

3. Congress has mandated encouragement of science, and the Office's actions are inconsistent with the Patent Act of 1793, authored by Thomas Jefferson, which defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter" Act of Feb. 21, 1793, 1, 1 Stat. 319, and with the Act which embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." [447 U.S. 303, 309].

4. Congress has mandated subject matter to be broad, and therefore the Office's actions are inconsistent with the 1952 Act requiring statutory subject matter to "include anything under the sun that is made by man." [*Diamond v. Chakrabarty* quoting S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952).].

5. Congress has stated that the Office shall respect Art. I, §8, cl. 8 [Patent Act of 1952, 35 U.S.C. 103]:

> **"Patentability shall not be negatived by the manner in which the invention was made."**

6. As a result, the Office has rejected the controlling authority of Art. VI which prohibits actions that interfere with the Constitution or laws passed by Congress including those arising from Art. I, §8, cl. 8, and leading to the creation, function, funding, operation, and aegis of the Office.

***-11 As discussed by the Petitioner, as shown by the claims themselves, as corroborated by the Declarants and *amicus curiae*, fusion and cold fusion are merely two environments where the inventions have great utility. Others environments include fuel cell technology, hydrogen storage, catalysis, energy storage and energy monitoring. In retrospect, this non-compliance by the PTO could have been avoided if the PTO recognized the controlling authority of Art. I, §8, cl. 8, and if the PTO's actions were consistent with the American Bar Association's most recent comments on new description guidelines of the PTO [http://www.uspto.gov/web/offices/com/sol/comments/utilitywd/aba.pdf] which says that the PTO should be "technologically neutral."

II

The Office has acted improperly exceeding even the bounds provided for Congress. This Court has previously noted that even Congress may not

> **"authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."**
> [*Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), 489 U.S. 141, No. 87-1346, quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 6 (1966)]

and therefore the Office, too, should not be able to remove knowledge of this field from the public domain or thereof restrict access.

The Office has taken the unauthorized and incorrect position that if any technology has a relation to cold fusion then it is *per se* unimportant and that its inventor will be denied Constitution protections afforded to other citizens (***-11). But this has been wrong, and a violation of Art. I, §8, cl. 8. As *amicus curiae* Fox has stated,

> "12. ... although an estimated 300 patent applications have been sent to the U.S. Office of Patents and Trademarks by inventors of new cold fusion devices and systems, no patents have issued citing the prior art. ..."
>
> "13. Inventors in other countries have been successful in obtaining patent protection by the governments. Over 100 low-energy nuclear reactions patents have issued in Japan and many more in various European countries ..."

To allow this usurpation of Art. I, §8, cl. 8 to stand will exalt temporary politically-correct (and scientifically-wrong) form over substance.

III

The Office's reliance upon art other than the actual original specifications and claims, *supra*, and its presumably "tongue-in-cheek" fabrication of "*excess heat*" in '937, *supra*, and its systematic failure to answer any of the Declarations,

heralds bias rather than the proper application of the standards of review for patentability under Art. I, §8, cl. 8.

By its systematic failure to use a uniform standard of review for patentability, by its ignoring Petitioner's Declarants, and by ignoring its own rules for patentability, the Office has denied due process and thereby Equal protection under the law [*United States v. Nixon*, 418 U.S. 683 (1974)].

> **"Today's patent statute is remarkably similar to the law as known to Jefferson in 1793. Protection is offered to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. 101**
>
> [*Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*]

This protection has been denied to Petitioner. As with the Office's denial of entry of Amendments (A187) with minor changes to overcome possible indefiniteness suggested by the Examiner in writing and in conversations, when they added neither new matter nor issues, is more than a violation of MPEP 707.07(j) and MPEP 706.03(d), but behavior which does not comport with any notion of fair play or justice. Discrimination has previously been important to the Court (***-12).

By ignoring standards of patentability, the decisions are arbitrary, selective, and capricious and encourage discrimination and civil rights violations under color of law [*U. S. v. Price*, 86 S. Ct. 1152, 1157] including due process and Equal protection under the law [5th Amendment and 14th Amendment] and other "equal protection" clauses [*Frontiero v. Richardson*, 93 S.Ct. 1736, 411 U.S. 677; *Weiss v. Weiss*, 436

(***-12) Civil Rights Acts of 1964 and 1991, the Americans with Disabilities Act of 1990, the Voting Rights Act of 1965, the Equal Credit Opportunity Act, the Equal Educational Opportunities Act of 1974, the Individuals With Disabilities Act, the Equal Pay Act of 1963, the Age Discrimination in Employment Act of 1967, the Age Discrimination Act of 1975, the Rehabilitation Act of 1973, Title IX of the Education Amendments of 1972, the Community Reinvestment Act of 1977, the Immigration Reform and Control Act of 1986, the Fair Housing Act of 1968, the Family and Medical Leave Act of 1993, and Executive Order 11246 (1965) as amended by Executive Order 11375 (1967).

N.Y.S. 2d. 862, 52 N.Y. 2d. 170 (1981)], with serious possible implications [*Gass v. Lopez*, 95 S. Ct 729; Wood v. Strickland, 95 S Ct 992: *U.S. v. Price*, 86 S Ct 1152, 1157, Footnote 7; *Griffin v. Breckenridge*, 91 S Ct 179D; *Gamez v. Toledo*, 42 *U.S.C. §1983*, and *Bivens v. Six Unknown Named Agents of Fed. Bureau of Narcotics*].

CONCLUSION

In '937 and '970, the putative "lack of operability" under 35 U.S.C. §112, ¶1 and "lack of utility" under 35 U.S.C. §101 has only been made by ignoring the original specification and claims, by ignoring the timely-submitted unrebutted Declarations, by ignoring scores of Exhibits and references, and by ignoring the Office's own rules, thus creating an arbitrary standard of review for patentability.

In '937, the putative "indefiniteness" under 35 U.S.C. §112, ¶2 has only been made by ignoring the reasoning of several decisions , the Office's own rules, and what those who were skilled-in-the-art at the time the original specification and claims were filed have stated [*In re Morris*] in unrebutted Declarations [*In re Marzocchi*] produced as required [*In re Oetiker*] which fully addressed all matters criticized by the Office regarding matters of fact. The Office has not provided any reason to doubt the objective truth of any of the Declarants' statements relied on for enabling support. No basis exists for a rejection under either section 112, ¶1 for operability lack of enablement or section 101 for lack of utility [*Environtech Corp. v. Al George, Inc.*].

The Office failed its Obligation to submitted unrebutted Declarations on fact issues.

The Office has not properly followed its own standards of review regarding patentability or its own Rules, and has shown abuse of discretion and has failed to comply with previous Orders by the Board for a response to said Declarants regarding material matters of fact (operability and utility).

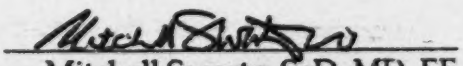
The Office's unfounded attack on "excess energy" which was not even mentioned in the '937 original specification and claims, and the Office's continual reliance upon reference to art cut of a cloth not even made from the original specifications and claims, in the light of the ignored unrebutted duly-submitted Declarations, herald that the Office's position must indeed be rather weak – which dictates allowance of the present inventions.

This case may initially appear to be *de minimis* because it involves atoms of hydrogen loaded into minute vibrating materials, but it is of great and compelling importance when measured by either the particular constitutional mandate of Art. I, §8, cl. 8 or the number of people dependent upon energy monitoring, efficiency and utilization, and alternative energy sources. Congress has spoken to "encourage progress" [*Diamond v. Chakrabarty*] and to encourage ingenuity [447 U.S. 303, 309] and has performed its constitutional role in defining patentable statutory subject matter to include "anything under the sun that is made by man." There is no doubt that would include inventions involving energy efficiency and energy and material monitoring within the meaning of the statute. Therefore, the Office has not acted following Congress lead as authorized by Art. I, §8, cl. 8.

Given that Congress has spoken, it is "the province and duty of the judicial department to say what the law is." [*Marbury v. Madison*]. This Court has final supervisory jurisdiction over the subject matter and should correct this situation by directing the Respondents to abide by their own Rules and standards of review.

Wherefore, Petitioner respectfully requests that this Petition for Writ of Certiorari be granted.

Respectfully submitted,



Mitchell Swartz, ScD, MD, EE
pro se, Petitioner
P.O. Box 81135
Wellesley Hills, MA 02481-0001
(781) 237-3625

Supreme Court of the United States

Mitchell R. Swartz, *Petitioner*

v.

Q. Todd Dickinson, Director of the USPTO,
Commissioner of Patents and Trademarks,
Respondent

On Petition For A Writ Of Certiorari
To United States Court Of Appeals
For The Federal Circuit
00-1107 (Serial No. 07/371,937)
00-1108 (Serial No. 07/760,970)

APPENDICIES

APPENDIX A - DECISION 00-1107 (Serial No. 07/371,937)
Issuing Court: US Court of Appeals for the Federal Circuit
Number of Case: 00-1107 (Serial No. 07/371,937)
Date of Denial: 11/08/00

IN RE MITCHELL R. SWARTZ

DECIDED: November 8, 2000
Before PLAGER, Circuit Judge, ARCHER, Senior Circuit Judge, and DYK, Circuit Judge. PER CURIAM.

Mitchell R. Swartz appeals from the decision of the Board of Patent Appeals and Interferences (Board), Appeal No. 94-2921, affirming the examiner's final rejection of claims 32-43 of application Serial No. 07/371,937 for lack of operability or utility under 35 U.S.C. § 101, lack of enablement under 35 U.S.C. § 112,¶ 1, and indefiniteness under 35 U.S.C. § 112, ¶ 2. We affirm the Board's decision.

The Board summarily affirmed the examiner's rejection of claims 32-43 under § 112, ¶ 2, because Mr. Swartz made no substantive arguments addressing the examiner's rejection. In the numerous briefs he filed with the Board, Mr. Swartz argued only that, after the final office action rejecting all pending claims, he had filed two amendments that addressed the indefiniteness rejection. The examiner had refused to enter the amendments because they would raise the issue of new matter, and the Commissioner had denied Mr. Swartz's petition under 37 C.F.R. § 1.181 requesting review of the examiner's decision. Although Mr. Swartz received notice that the brief he filed with the Board did not comply with the requirements of 37 C.F.R. § 1.192(c) because it did not address the indefiniteness rejection, he continued to argue only that his proposed amendments properly addressed the rejection under § 112, ¶ 2. Mr. Swartz reiterates that argument on appeal to this court.

We agree with the Board that Mr. Swartz did not present any substantive arguments addressing the rejection under § 112, ¶ 2. Mr. Swartz argued that the proposed amendments would overcome the rejection, but the amended claims were not before the Board. The Board could consider only the rejection of the non-amended claims, and Mr. Swartz presented no reasons why the Board should sustain the examiner's indefiniteness rejection of those claims.

Mr. Swartz contends that the Board should have addressed the examiner's refusal to enter his proposed amendments after the final rejection. That decision, however, was not before the Board. Nor is that decision before this court. Nevertheless, we observe that Mr. Swartz's proposed amendments were not merely amendments suggested by the examiner to address the indefiniteness problem. While the examiner made some suggestions, he made no representation that those suggestions would overcome the indefiniteness rejection. More importantly, Mr. Swartz proposed an additional claim limitation not suggested by the examiner, and it was that limitation that the examiner determined would raise the issue of new matter.

We conclude that the Board properly affirmed the examiner's rejection under § 112, ¶ 2 because Mr. Swartz presented no substantive arguments. We also conclude that the Board did not err in failing to review the examiner's refusal to enter amendments after final rejection. Because we affirm the Board's decision sustaining the rejection under § 112, ¶ 2, we need not address the Board's decision sustaining the rejections under § 101 and § 112, ¶ 1.

❑

APPENDIX B - DECISION 00-1108 (Serial No.07/760,970)
Issuing Court: US Court of Appeals for the Federal Circuit
Number of Case: 00-1108 (Serial No.07/760,970)
Date of Denial: 11/08/00

IN RE MITCHELL R. SWARTZ

DECIDED: November 8, 2000
Before PLAGER, Circuit Judge, ARCHER, Senior Circuit Judge, and DYK, Circuit Judge.
PER CURIAM.

Mitchell R. Swartz appeals from the decision of the United States Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences (Board), Appeal No. 94-2920, affirming the examiner's final rejection of claims 25-48 of application Serial No. 07/760,970 for lack of operability or utility under 35 U.S.C. § 101 and lack of enablement under 35 U.S.C. § 112, ¶ 1. We affirm the Board's decision.

The questions of whether a specification provides an enabling disclosure under § 112, ¶ 1, and whether an application satisfies the utility requirement of § 101 are closely related. Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1358, 52 USPQ2d 1029, 1034 (Fed. Cir. 1999). To satisfy the enablement requirement of § 112, ¶ 1, a patent application must adequately disclose the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation. Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 1371-72, 52 USPQ2d 1129, 1136 (Fed. Cir. 1999). The utility requirement of § 101 mandates that the invention be operable to achieve useful results. See Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992). Thus, if the claims in an application fail to meet the utility requirement because the invention is inoperative, they also fail to meet the enablement requirement because a person skilled in the art cannot practice the invention. See Process Control, 190 F.3d at 1358, 52 USPQ2d at 1034; see also In re Ziegler, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) ("The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. § 101 that the

specification disclose as a matter of fact a practical utility for the invention."). Lack of utility is a question of fact, In re Cortright, 165 F.3d 1353, 1356, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999), and the absence of enablement is a legal conclusion based on underlying factual inquiries, Enzo, 188 F.3d at 1369, 52 USPQ2d at 1134. In appeals from the Board, we review questions of fact for substantial evidence. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). We exercise independent review over the conclusion of whether a disclosure is enabling. Enzo, 188 F.3d at 1369,52 USPQ2d at 1134.

The PTO has the initial burden of challenging a patent applicant's presumptively correct assertion of utility. In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). If the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility, however, the burden shifts to the applicant to submit evidence sufficient to convince such a person of the invention's asserted utility. Id. Here the PTO provided several references showing that results in the area of cold fusion were irreproducible. Thus the PTO provided substantial evidence that those skilled in the art would "reasonably doubt" the asserted utility and operability of cold fusion. The examiner found that Mr. Swartz had not submitted evidence of operability that would be sufficient to overcome reasonable doubt. After its review of the evidence, the Board found that Mr. Swartz had "produced no persuasive objective evidence, in our view, that overcomes the examiner's position."

Regarding the enablement requirement, the PTO found that the written description in Mr. Swartz's application contains no disclosure of any operative embodiment. Thus, in order to practice the claimed invention, a person of ordinary skill in the art would have had to rely on the art known at the filing date, September 19, 1991. For reasons similar to those forming the basis for his finding that Mr. Swartz had not submitted evidence of operability, the examiner found that Mr. Swartz had not submitted evidence that the concept of the invention could have been practiced by a person skilled in the art at the time of the invention without undue experimentation. The Board found that Mr. Swartz's arguments did not overcome the examiner's position, and accordingly sustained the examiner's enablement rejection. On this appeal, Mr. Swartz complains that the Board "ignored" evidence that he submitted and disregarded his arguments, and he invites this Court to examine voluminous record material that he urges supports his position on the issue of utility. Such conclusory allegations in an appeal brief are quite insufficient to establish that the Board's decision on the issue of utility is not supported by substantial evidence or to establish that the Board's ultimate conclusion of a lack of enablement is incorrect as a matter of law.

Finally, Mr. Swartz's attempt to show that his claims are directed to a process other than cold fusion must fail. In his written description and throughout prosecution of his application, Mr. Swartz continually represented his invention as relating to cold fusion.

For the reasons discussed above, the Board did not err in concluding that the utility of Mr. Swartz's claimed process had not been established and that his application did not satisfy the enablement requirement.

Accordingly, the judgment of the Board is

AFFIRMED.

□

APPENDIX C - ORDER DENYING REHEARING DECISION 00-1107 (Serial No 07/371,937)

Issuing Court: US Court of Appeals for the Federal Circuit
Number of Case: 00-1108 (Serial No.07/760,970)
Date of Denial: 12/06/00

ORDER

Before DYK, Circuit Judge, ARCHER, Senior Circuit Judge, and PLAGER, Senior Circuit Judge*.

A petition for rehearing having been filed by the APPELLANT,

UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on January 2, 2001, unless another time becomes appropriate under Rule 41.

FOR THE COURT,
-s Jan Horbaly
Clerk

Dated: December 6, 2000

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
DEC 6, 2001

CC: Mitchell R. Swartz
Albin F. Drost
Thomas Valone, Hal Fox

IN RE SWARTZ, 00-1107
(PTO - 07/371,937)

* Circuit Judge Plager assumed senior status on November 30, 2000.

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX_D - ORDER DENYING REHEARING
DECISION 00-1108 (Serial No.07/760,970)

Issuing Court: US Court of Appeals for the Federal Circuit
Number of Case: 00-1108 (Serial No.07/760,970)
Date of Denial: 12/06/00

ORDER

Before DYK, Circuit Judge, ARCHER, Senior Circuit Judge, and PLAGER, Senior Circuit Judge*.

A petition for rehearing having been filed by the APPELLANT,

UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on January 2, 2001, unless another time becomes appropriate under Rule 41.

FOR THE COURT,
-s Jan Horbaly
Clerk

Dated: December 6, 2000

U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT
Dated: December 6, 2000

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
DEC 6, 2001

IN RE SWARTZ, 00-1108
(PTO - 07/760,970)

* Circuit Judge Plager assumed senior status on November 30, 2000.

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX E - CLAIMS OF SUBJECT MATTER

SERIAL NO. 07/371,937

Claim 32. In a process for producing a product from an isotopic fuel using a material which is electrochemically loaded, a method for monitoring the isotopic fuel within said material that comprises:

mechanically coupling said material to enable a mechanical vibration of said material,

providing means for exciting said vibration,

following the frequency of said vibrational state.

❑

SERIAL NO. 07/760,970

Claim 25. In a process for producing a nuclear fusion product from an isotopic fuel using a material, a two-stage method for controlling said reaction which includes in combination:

supplying an isotopic fuel to said material,

loading said isotopic fuel into said material to saturate said material,

then creating a change in the active quantity of said fuel within said material by desaturation,

creating thereby a catastrophic diffusion flux of said isotopic fuel within said material[s]."

❑

APPENDIX F

LIST OF IGNORED UNREBUTTED TIMELY-SUBMITTED DECLARATIONS

Exhibits in Each US Court of Appeals for the Federal Circuit
Appendix 00-1107 and 00-1108,
Prepared Pursuant to FRAP 30(a)(1)(B)

IN RE SWARTZ, 00-1107 (07/371,937)	
Declaration Supporting Appeal to Board	A18
Declaration of Straus	A44
Declaration of Swartz with 2nd Reply Brief	A49
Excerpts Second Reply Brief (1-4,14)	A57
Declaration of Bass	A62
Declaration of Mallove	A66
Declaration of Fox	A72
Declaration of Rotegard	A75
Declaration of Swartz with Reply Brief	A77
Letter Miles	A78
Letter Ahern	A79
Letter Kurzweil	A80
IN RE SWARTZ, 00-1108 (Serial No.07/760,970)	
Declaration of Straus	A10
Declaration of Swartz with Reply Brief	A13
Declaration of Bass	A22
Declaration of Mallove	A26
Declaration of Fox	A32
Declaration of Rotegard	A35
Letter Miles	A37
Letter Ahern	A38
Letter Kurzweil	A39

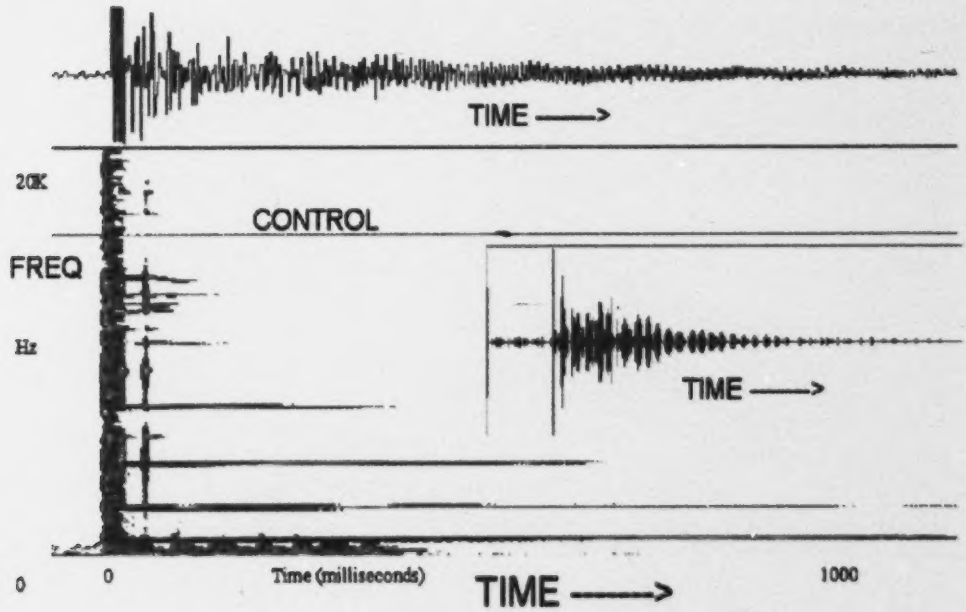
APPENDIX G

Pleadings, Declarations, Exhibits Submitted

The submitted Declarations and Exhibits for '937 are on the left. Those from case '970 are on the right. These constitute more than three hundred references, more than thirty publications by the Petitioner and Petitioner's constituting considerable weight (more than 140 pounds).

In '937, the Office's "docket" is inaccurate in several ways. Forty-three (43) pleadings, Declarations, and letters sent by the Appellant were not recorded, and Declarations have been incorrectly listed as "letters". It also ignores that six (6) pleadings of, or communications by, the Office were not sent to the Appellant. No explanation is given for the eighteen (18) Office's entries out-of-order temporally, indicating that the purported "Docket" was not made contemporaneously [Appendix A1-A7 (corrected A8-A11, proof A12-A17)] and in defiance of the Office's date stamps (A12) and in violation of 18 U.S.C. 2071. These events have prejudiced the Appellant.

In '970, the Office's "docket" is inaccurate in several ways. Thirty seven (37) of Appellant's pleadings and Declarations were not recorded. The Board has confirmed this in a remand (A82). As many as six (6) pleadings of, or communications by, the Office were not sent to the Appellant. The analysis reveals that, curiously, seven (7) of the Office's entries are out of order, indicating that the purported "Docket" was not made contemporaneously. These events have prejudiced the Petitioner. ⌋



Vibrations Of An Electrode ['937]

This figure from Swartz, M., "Possible Deuterium Production From Light water excess enthalpy experiments using Nickel Cathodes", *Journal of New Energy*, 3, 68-80 (1996). demonstrates both utility and operability (questions of fact). Convincingly demonstrated are monitored vibrational frequencies ("vibrations") of an electrode as a function of frequency and time using the teachings of '937. The vibrations (which the Office says cannot exist) are shown as horizontal lines which disappear in seconds. The vibrations are the "normal modes" of the system, like a swing or pendulum has a natural frequency.

After beginning the vibration with a single forced pulse at t=0 [confer original specification of '937], and picking up the signal with two audio transducers (top and mid-right hand side), the short-lived vibrational modes of the electrode are dramatically revealed by computed processing using a fast fourier transform (FFT; bottom and lower left; the frequencies are vertical and time is horizontal). A calibration signal ("control") was inserted at $17{,}390^{+/-53}$ Hz. and it is the blue horizontal line approximately half-way up the image. The sampling rate was ~100 kilohertz, and the cathode was #92-505b/Ni-B2 immersed in ordinary water using the teachings of the present original specification and claims. ❑